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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,183	03/10/1999	MARCO SCIBORA	90020-12	5426

32300 7590 02/21/2006

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EXAMINER

FLANDERS, ANDREW C

ART UNIT PAPER NUMBER

2644

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/266,183

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Schiborg, Marco

3304613

EXAMINER

Andrew C. Flanders

ART UNIT

PAPER

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20060208

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Commissioner for Patents

The attached is the Examiner's Response to the Reply Brief filed 01 December 2005

DETAILED ACTION

Response to Arguments

Applicant's arguments in the Reply Brief filed 01 December 2005 have been fully considered but they are not persuasive. The response is stated below and the case has been forwarded to the Board of Patent Appeals and Interferences.

As to Claim 17:

Applicant Alleges:

“Cook does not disclose a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer. There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer.”

To substantiate this allegation, Applicant states “Cook merely discloses a method to gain access to the system”

Examiner respectfully disagrees. Examiner does not agree that Cook discloses a method to gain access to the system. However assuming that Cook does, Applicant

fails to acknowledge the manner in which the user gains access to the system. The user receives a "gift number" (col. 5 lines 25 – 30) which is used to gain access to the system. Giving the claim limitations their broadest reasonable interpretation consistent with the specification, one may conclude that the act of using the gift certificate/number for accessing the system and creating a disc reads upon the limitation of a scannable purchase card having a unique bar code (i.e. gift number) keyed (i.e. the gift certificate/number is redeemed) to the music selections chosen by the customer.

In fact, as shown in the Examiner's Answer, Applicant's specification states "... The purchase card 130 will be encoded with a **unique barcode**... which allows purchases to be made". Thus, using Cook's gift certificate/number is in fact operating in the same manner as Applicant is claiming in its broadest reasonable interpretation.

It appears to the Examiner as though Applicant may have indented to gain protection for "linking each song to a single unique barcode" as disclosed on page 11 of Applicant's specification.

While Applicant may believe these limitations are within the claim language, the Examiner believes the currently presented claim language also allows for the interpretation of the unique barcode being used to purchase a disc (i.e. keyed).

To further substantiate the allegations Applicant further states:

"Also as previously presented, such a gift certificate is not used for ordering the CD, in fact the CD is ordered as disclosed at column 7 lines 20 - 45. The customer, that is the original customer, or a third party

possessing a gift certificate, receives an order confirmation No. by which the job is managed by the system and tracked by the customer. There is no disclosure of any part of the order been keyed onto the gift certificate. When the CD is ready the customer is notified, typically by an e-mail message, with the tracking number. If the order had been keyed to the gift card or certificate, there would be no need for the customer to be notified with the tracking number.”

Examiner respectfully disagrees.

As a first matter, the emphasized portion of Applicant's arguments are not present in the claim language. The term onto differs substantially from the currently presented claim language of “to”. Applicant is not claiming the selections are keyed onto but rather keyed to. When using the phrase “keyed onto” it implies data is placed in the barcode , however when using the term “keyed to” (which is the form present in the claim language), it leaves open the interpretation used in the rejection (scanning a card to purchase a custom CD).

Further, Examiner is unsure of the reasoning used by Applicant in these allegations. It appears as though Applicant points to column 7 lines 20 – 45 to show that the gift certificate is not used for ordering the CD. However, Applicant has previously stated that the gift certificate/number is merely used for accessing the service. Examiner does not agree with this, but if it is assuming it is true, the text cited by Applicant, particularly line 20, it specifically sates “A user accessing the system

selects a set of recordings..." and ... "after the CD is finalized, the customer's payment method is finalized." Examiner is unsure how Applicant can suggest that the gift certificate/number is used for accessing the system and then say it is not used to purchase the CD when the portions cited by applicant (col. 7 lines 20 – 45) clearly show that by accessing the system, the user is enabled to create and purchase a CD.

In sum, Applicant is claiming that the gift certificate is used in accessing the system, yet in col. 7 lines 20 – 45 Cook discloses creating a CD by accessing the system.

To further substantiate the allegations Applicant further states:

"Plus the office action is incorrect that implementing a scannable number with a barcode would have been suggested to one of ordinary skill in the art by the disclosure of Cook, as there is no such disclosure, and the system operates completely differently."

Examiner respectfully disagrees that the system operates completely differently as is shown above. Further, per the MPEP, language is not meant to be read in a vacuum. As shown before, the manner in which the number is stored on Cook's gift certificate is irrelevant as the various notoriously well known methods (barcode, punch number, magnetic strip...) do not provide any new or unexpected result. All of these methods are notoriously well known in the art for use in retail environments for completing transactions.

Furthermore Applicant is reading the term “keyed” as “related to” without considering an alternative definition of the word. Examiner is unable to find a clear lexographic definition of the term “keyed” in Applicants disclosure as required by MPEP section 2111, only a description with the term in various embodiments. Since there is no clear definition the term should be given its plain meaning by one of ordinary skill in the art.

It is well known that when a person wishes to purchase something, perhaps with a credit card or gift card, the cashier or automated system “keys” in the number. The mere act of keying in this number to purchase a custom CD implies that those tracks selected are keyed to the gift card through the purchase. This is shown on any standard receipt which may display the method of purchase (cash, credit, gift card) and the purchase which allows for the interpretation of keying the selections to the number disclosed by Cook.

As to Claim 18:

Applicant Alleges:

“Once again, Cook does not disclose the steps (e), (f), (g), and (h). Cook does not disclose scanning the purchase card to obtain the unique barcode; keying each selected track to the unique barcode, scanning the purchase card at a checkout station

to obtain the unique barcode', and recording the selected tracks keyed to the unique barcode on a compact disc cutter."

Applicant substantiates this by alleging that the prior statement of the examiner (i.e. the gift certificate would inherently contain a predetermined value (i.e. \$20, \$30... etc) and at checkout the cashier or machine would notify the customer if insufficient funds were present) are made without supporting evidence in the disclosure.

Examiner respectfully disagrees. Per the MPEP, language is not meant to be read in a vacuum. Examiner maintains the position that a gift certificate has an inherent value and using the gift certificate to purchase more than the value will return an insufficient funds response. A "gift certificate" is notoriously well known in the art to operate in this manner. Applicant merely makes a statement that the Examiners position (without evidence or reasoning) is without supporting evidence in reference, however, the Examiner maintains the position that "a gift certificate" is notoriously well known in the art.

Applicant further substantiates this allegation by stating:

Again the gift certificate of Cook is not used in producing the music selections. This is used only in accessing the system.

Again, this is completely unfounded. Applicant is claiming that the gift certificate is used in accessing the system, yet in col. 7 lines 20 – 45 Cook discloses creating a CD by accessing the system.

As to Claim 19:

Applicant Alleges:

"Cook does not disclose steps (a), (h), (j), (k), (l) or (q). There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer."

Examiner respectfully disagrees for the reasons stated above regarding the arguments as to claim 17.

As to Claim 21:

Applicant Alleges:

"Cook also does not disclose the further limitation of claim 21 of the customer purchasing the purchase card after selecting tracks to be purchased."

Applicant attempts to substantiate this argument by stating "The only disclosure in Cook of a gift card is at column 5 lines 22 through 30. Cook clearly discloses that a customer first purchases the gift certificate and then a third-party accesses the service

by going to the retail establishment and supplying the gift number or token to the network machine and selecting tracks to be purchased. Far from being irrelevant, the order of operation in Cook is absolutely required for operation', it is impossible for the third-party to have the gift certificate and access the service until the customer purchases the gift certificate."

Examiner respectfully disagrees. Again, it appears as though Applicant is making the assumption that the gift certificate is required to access the system (as further realized through the previous arguments), which is completely unfounded. If Applicant is correct in stating the gift certificate is used to access the system, how is one using a credit card as a method of payment would be able to access the system? (col. 5 lines 20 – 25 discloses a credit card reader for receiving credit card information for the purchase). The disclosure does not provide any indication that a gift certificate is required and the only way to access the system, merely that the gift certificate is a method of payment. The fact is that the system is accessed and a CD mix is made **before** any payment is made (see further col. 3 lines 20 – 45; the user accesses the system, selects the tracks, then pays). Thus, the time when the gift certificate is purchased in relation to the time the CD tracks are arranged is completely irrelevant. A person may purchase the gift card and then select the tracks, or select the tracks and then purchase the gift card.

Conclusion

Art Unit: 2644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7546. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER